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| 09/200,853 | 11/30/1998 | YASUHIRO YAMAMOTO | P17029 | 9849 |
| 7590 03/26/2004 GREENBLUM & BERNSTEIN 1941 ROLAND CLARKE PLACE RESTON, VA 20191 | | | EXAMINER GHEE, ASHANTI | |
| | | | ART UNIT 2626 | PAPER NUMBER |

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/200,853

Applicant(s)

YAMAMOTO, YASUHIRO

Examiner

Ashanti Ghee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-12 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2002 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the following communication: amendment D filed on 1-12-04.
2. This application has been reconsidered. Claims 1-15 are pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-5, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Kondo (US Patent No. 5,930,003).

Regarding claim 1, Kato discloses an image reading device comprising: a housing (Fig. 1); a reading processor (CCD scanner 16 reads on reading processor) that optically reads an image recorded (inherent that capturing images reads on optically reads an image recorded) on a recording material sheet (inherent that original

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document reads on recording material sheet since a document is generated from a sheet of paper) to generate an image (produces image data reads on generate image data; col. 6, lines 34-48); an image data transmitting processor (CPU 10 reads on image data processor; col. 5, lines 51-55) that can transmit (facsimile transmission reads on transmit) said image data (image data) externally to a peripheral device (personal computer 2 reads on externally to a peripheral device; col. 8, lines 7-46); an image data recording processor (CPU 10 reads on image data processor; col. 5, lines 51-55) that can record (store reads on record) said image data (image data) in a recording medium (RAM 15 reads on recording medium) mounted in said housing (col. 6, lines 34-48)

Although Kato does not disclose a recording operation determination processor that determines, based on whether said recording medium is mounted in said housing, whether a recording operation of said image data recording processor is possible; and a control processor that, when said recording operation determination processor determines that said recording operation is impossible, prohibits said recording operation and allows said image data transmitting processor to transmit said image data to said peripheral device, Kondo discloses a recording operation determination processor (system controller 1, col. 2, lines 29-40) that determines (determined), based on whether said recording medium is mounted in said housing (if RAM can include a hard disk then this reference can be modified to determine if a floppy disk has been installed/mounted in the hard disk/housing, see col. 2, lines 64-67), whether a recording operation (storing) of said image data recording processor (facsimile apparatus, col. 2, lines 26-28) is possible (col. 4, lines 1-14); and a control processor (1) that, when said

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recording operation determination processor (1) determines (determined) that said recording operation (storing) is impossible (impossible), prohibits (interrupted) said recording operation (storing) and allows (transmitted) said image data transmitting processor (NCU 8, see col. 3, lines 1-8) to transmit (transmitted) said image data (data) to said peripheral device (it is obvious that the data is being transmitted to another receiver/recipient; col. 4, lines 1-14).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Kato and Kondo due to both references disclosing an image reading device to provide a facsimile apparatus that can appropriately manage the memory-full status of an image memory upon receiving or transmitting data.

Regarding claim 2, Kato discloses a device further comprising a display device (LCD 22 reads on display device) that indicates said recording operation (storing reads on recording operation) is prohibited (fax memory has become full reads on recording operation is prohibited) when said recording operation determination processor (10) determines that said recording operation is impossible (col. 8, lines 49-col. 9, lines 1-25).

Regarding claim 4, Kato discloses a device wherein said recording operation determination processor (10) determines whether said recording operation (storing reads on recording operation) is possible based on a remaining recordable volume (fax memory reads on recordable volume) of said recording medium (col. 8, lines 49-col. 9, lines 1-25).

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Regarding claim 5, Kato discloses a device wherein said recording operation determination processor (10) determines whether said recording operation (storing reads on recording operation) is possible based on a formatting state (available storage capacity in the RAM 15 reads on formatting state of said recording medium) of said recording medium (col. 10, lines 50-col. 11, lines 1-36).

Regarding claim 12, Kato discloses an image reading device comprising: a device (CCD scanner 16) that optically reads an image recorded (inherent that capturing images read on optically reads an image recorded has been performed) on a recording material sheet (inherent that original document reads on recording material sheet) to generate image data (produces image data reads on generate image data; col. 6, lines 34-48); a device (I/O port 3; col. 5, lines 39-43) that transmits said image data (image data reads on image data) to a computer (personal computer 2 reads on computer) provided externally to said image reading device (facsimile machine 1 reads on image reading device; col. 10, lines 50-col. 11, lines 1-36).

Although Kato does not disclose a recorder that records said image data in a recording medium that is readily removable from and reattachable to said image reading device, a device that determines, based on a state of said recording medium, whether a recording operation of said recorder is possible; and a device that controls said transmitting device and said recording device and prohibits said recording operation and allows said device to transmit said image data to said computer when said device that determines said recording operation is impossible, Kondo discloses a recorder (recording unit 3, sol. 2, lines 46-48) that records (records) said image data (image) in a

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recording medium (hard disk, col. 2, lines 64-67) that is readily removable from and reattachable (it's obvious that a hard disk can include a floppy disk, therefore having a readily removable and reattachable medium) to said image reading device (facsimile apparatus, col. 2, lines 26-28; col. 2, lines 26-67), a device (system controller 1, see col. 2) that determines (determined), based on a state of said recording medium (if the left available amount is smaller than page memory size), whether a recording operation (storing) of said recorder (memory) is possible (possible; col. 3, lines 61-col. 4, lines 1-14); and a device (NCU 8, col. 34, lines 1-8) that controls (has function) said transmitting device (transmitting) and said recording device (3) and prohibits (interrupted) said recording operation (storing) and allows (transmitted) said device (8) to transmit (transmitted) said image data (data) to said computer (it's obvious that the transmission is being sent to a receiver and that receiver device can be a computer) when said device that determines said recording operation is impossible (col. 4, lines 1-14).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Kato and Kondo due to both references disclosing an image reading device to provide a facsimile apparatus that can appropriately manage the memory-full status of an image memory upon receiving or transmitting data.

Claim Rejections - 35 USC § 103

6. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Kondo (US Patent No. 5,930,003) further in view of Moronaga et al. (US Patent No. 5,473,370).

Regarding claim 6, Kato and Kondo do not specifically disclose a device wherein said recording operation determination processor determines whether said recording operation is possible based on a type of said recording medium.

However, Moronaga discloses a device wherein said recording operation determination processor determines whether said recording operation is possible based on a type of said recording medium (col. 9, lines 36-42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Kato, Kondo, and Moronaga due to all of the references disclosing an image reading device to greatly simplify the operation for the user.

Regarding claim 7, Kato and Kondo do not specifically disclose a device wherein said recording medium comprises a memory card. However, Moronaga discloses a device wherein said recording medium comprises a memory card (col. 24, lines 24-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Kato, Kondo, and Moronaga due to all of the references disclosing an image reading device to greatly simplify the operation for the user.

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Regarding claim 8, Kato and Kondo do not disclose a device wherein said memory card comprises a PC card. However, Moronaga discloses a device wherein said memory card comprises a PC card (col. 24, lines 24-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Kato, Kondo, and Moronaga due to all of the references disclosing an image reading device to greatly simplify the operation for the user.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Kondo (US Patent No. 5,930,003) further in view of Suzuki (US Patent No. 6,347,162).

Regarding claim 9, Kato and Kondo do not disclose a device wherein said recording medium comprises a magneto-optical disc. However, Suzuki discloses a device wherein said recording medium comprises a magneto-optical disc (col. 7, lines 35-37).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Kato, Kondo, and Suzuki due to all of the references disclosing image reading devices to provide prompt and simple operation.

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8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Kondo (US Patent No. 5,930,003) further in view of Hirai et al. (US Patent No. 5,315,403).

Regarding claim 10, Kato and Kondo do not disclose a device wherein said recording medium comprises a magnetic disk. However, Hirai discloses a device wherein said recording medium comprises a magnetic disk (col. 3, lines 26-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Kato, Kondo, and Hirai due to all of the references disclosing an image reading device to provide a storage medium having the high storage speed to transfer image information to a storage medium having a low speed.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (US Patent No. 5,898,824) in view of Kondo (US Patent No. 5,930,003) further in view of Yoshiura et al. (US Patent No. 5,854,693).

Regarding claim 11, Kato and Kondo do not specifically disclose a device wherein the peripheral device comprises a computer. However, Yoshiura discloses a device wherein said peripheral device comprises a computer (col. 52, lines 3-7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Kato, Kondo, and Yoshiura due to all references disclosing image reading devices to provide a visible image in a short period of time.

Allowable Subject Matter

10. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. Claim 15 is allowed.
12. The following is a statement of reasons for the indication of allowable subject matter: Claim 15 are allowable over the prior art of record because the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches an image reading device that comprises a housing, a reading processor, an image data transmitting processor, an image recording processor that is configured to record the image data in a detachable/reattachable recording medium to the housing, a recording operation determination processor, and a control processor, respectively, as set forth in Claim 15 including all of the features recited therein.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kuwahara (US Patent No. 6,603,579) discloses a facsimile apparatus.

Sato et al. (US Patent No. 6,587,220) discloses an image recording apparatus provided with an original reading apparatus.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443. The examiner can normally be reached on Mon-Thurs and alt. Fri. (7-4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



AG
March 21, 2004

Ashanti Ghee
Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER